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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/363,499	07/29/1999	DAVID B. SUTTON	9204-000001	8198

7590 02/10/2003

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EXAMINER

BERGIN, JAMES S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/363,499

Applicant(s)

SUTTON ET AL.

Examiner

James S. Bergin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Declaration filed on 9/18/2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Wisdom et al. US 6,145,741 reference.

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Wisdom et al. US 6,145,741 reference, 4/27/0999.

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Exhibit A, "PrivaCard mock up", does not prove that the inventors conceived the claimed method steps of the method invention of independent claim 18 (as amended by Preliminary amendment filed 10/22/2002). Exhibit A does not show the step involving the purchasing intermediary.

Drawings

3. As indicated in the previous actions mailed 5/7/02, Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisdom et al. (6,145,741).

Wisdom et al. disclose a prepaid universal purchasing card for purchasing petroleum or non-petroleum related products such as sundries from a retail establishment such a filling station (see abstract). The Wisdom et al. pre-paid card need not be encoded so as to identify the individual that purchases the card, thereby allowing such an individual to remain anonymous (see abstract, "...optional encoding identifying it with a particular user,...") Wisdom et al. do not specifically disclose that the universal pre-paid card is initially purchased by a purchasing intermediary and then supplied to the retail establishment for resale to the end user of the card. However, the insertion of a purchasing intermediary or a "middle man" in a supply chain is notoriously well known in the art to those possessing even the most basic knowledge thereof, such purchasing intermediaries enhancing the distribution of the card. Thus it would have been obvious to one of ordinary skill in the art at the time that the invention was made that a purchasing intermediary could be readily inserted in the distribution pathway of

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the Wisdom card, so as to aid the distribution thereof and to enhance it's widespread availability.

Regarding claim 20 and 21, Wisdom et al. discloses that the cards possess one or more authenticating and security codes recorded in each card, such codes being read by well known conventional card reading apparatus at each point of sale where the cards are accepted (see block 14 in figure 1, and column 3, lines 34-39).

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wisdom et al. (6,145,741) as applied to claim 18 above, and further in view of Walker et al. (5,794,207).

Wisdom et al. do not disclose *"sending a purchased good by the retailer to an intermediary shipping address associated with the purchasing intermediary; and forwarding the purchased good to the purchaser by the purchasing intermediary, thereby maintaining the anonymity of the purchaser"*.

Walker et al. disclose a purchasing system which involves the use of trusted third party intermediaries having intermediary shipping addresses which provide a relay system for the delivery of goods and services to the purchaser and which thereby allows the purchaser to remain anonymous from the retailer (col. 7, lines 52 – 58).

It would have been obvious, in view of Walker et al., to one of ordinary skill in the art at the time that the invention was made, to provide the pre-paid card purchasing system of Wisdom et al. with an intermediary shipping address to which the purchased goods could be shipped, so as to enable the purchaser using the pre-paid purchasing card to remain anonymous from the retailer.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-7687 for regular communications and 703 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1113.

JSB
February 6, 2003



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600